REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-5 remain in the application. None of the claims have been amended.

The continued rejection and the finality of the Office action have been noted. Applicants have also carefully studied the Examiner's comments and his response to our previously proffered arguments. Several comments require a reply.

(1) "Applicants have neither referred to their specification nor provided an affidavit in support of their allegations."

The fact that the Examiner has withdrawn the prior rejection indicates that such affidavits were not necessary. In fact, the rejection should never have been made, because the invention was properly enabled by the specification in light of the state of the art.

(2) "Respectfully, this appears to be a step backward in the art."

The Examiner is respectfully requested to abstain from commenting on his personal opinion as to the value of the invention. Value judgments often cloud objectivity. Besides, the reasons for and the advantages of providing the novel features in a standalone implementation are detailed in the specification.

(3) "Applicants allege . . . that the 'hearsay rule' is 'clearly not applicable', but offer no explanation for the opinion . . . Applicant's reference to 'explicit words' is lacking and misleading."

In fact, the explanation was proffered in a concise summary of the applicable legal background and the legal theory. There was nothing misleading in the explanation. The hearsay rule is indeed misplaced in the context. The reference to Ishigami et al. is not proper prior art, to wit:

(a) The Ishigami et al. patent application was published on Dec. 27, 2001. The instant application was filed May 30, 2001. That is, the Ishigami et al. content was not published before the invention by applicants.

(b) Ishigami et al. describes certain details about use "by others" of something that may or may not be considered the invention. Assuming, *arguendo*, that the "prior art" description in the patent indeed describes the claimed invention, it suggests that the "invention was used by others" not in the United States. As apparently recognized by the Examiner, the Ishigami et al. disclosure is based on a Japanese priority application. If at all, the "use" of the invention "by others" points to Japan.

(c) The statute, 35 U.S.C. § 102(a), is entirely clear: If known or used by others is alleged, it must have been in the United States. If the Office relies on a printed publication, it may be in this or a foreign country.

Simply stated, the patent to Ishigami et al. and its prior art allegations do not carry the Examiner's burden to prove that the invention is unpatentable under § 102(a).

(4) "Applicant's allegations regarding Beall et al. are, respectfully, misleading and taken out of context."

Responding to a rejection over the reference Beall et al. (US 6,169,992 B1 "Beall") is quite difficult. Beall is a prolix patent that contains an enormous amount of detail. Counsel would never intentionally make misleading statements, or take information out of context. Should such indeed have happened, counsel apologizes to the Examiner. On revisiting the reference and once more studying the disclosure, however, we are still entirely sure that Beall does not anticipate the claimed invention under 35 U.S.C. § 102(e). Furthermore, Beall also does not render the claimed invention obvious under 35 U.S.C. § 103.

The instantly claimed invention deals with standalone simulators and with their adaptation to a specific electronic component. Claim 1 of the instant application calls for a method in which a computer-executable file with a standalone simulator is stored and offered for download and in which the consumer is enabled to execute a simulation in standalone mode. Claim 4 deals with a product support system in which standalone simulators are stored, offered for download and enabled for execution in standalone mode as a standalone simulator.

Notwithstanding the Examiner's comments, Beall deals with on-line simulators and catalogs. Beall allows an applet to be downloaded and executed within the user's web browser. The necessary data for display and processing in the applet is provided by the on-line server. As a matter of fact, Beall describes a system where a part may have "additional information associated with it on the World Wide Web." Col. 15, lines 57-58. When the user clicks on a specific link, an HTML document may

be accessed or an applet may be downloaded with executable content. Beall provides an example, namely, "a circuit simulation applet to model the selected integrated circuit's performance." Col. 15, line 66, to col. 16, line 1. As explained in the prior response, Beall continues with instructions on how the user is enabled to browse the necessary information and choose from additional information. If nothing else, that disclosure at least suggests that the user remain connected to the Internet.

The question, then, is whether or not Beall also shows or suggests a standalone executable application.

We believe that the reference does not. Beall's preferred system downloads an applet into the web browser. An applet is a Java application program that becomes (temporarily) resident in a web browser and it acts as a user interface. The applet is indeed executable within the web browser, but it still requires additional data (i.e., information content) for processing. Such additional data is brought down through a distributed network, namely, the Internet, a WAN, a LAN, or the like. Beall's user remains connected to the server during the execution of the applet. The applet is not a computer-executable file with a standalone simulator. Beall's program does not execute a simulation in standalone mode.

Intermediate interruptions of the connection are acceptable to Beall. For a certain time, one would assume, the web browser and its applet can execute in off-line mode. Such processing is only temporary, however, as the system requires data download that continues during the process. Beall details several routines to handle

temporary disconnections. See, for example, the description of Fig. 16 and the related flowchart of Figs. 13A and 13B.

The Examiner is certainly correct that Beall explains optional access by the user of additional information ("The user may choose to browse . . ."). The admonishment, however, that applicant's allegations are misleading is not well taken. What the terminology "may choose" indicates is that such an option is provided to the user. The option can only be available, of course, if the user is connected to a network such as the Internet. The option could not be offered if the user were truly in standalone mode. Processing information in a browser-resident applet – even if the browser is taken offline temporarily, yet the user retains the option to return to online mode at any time – is not a standalone application.

Claim 1 with its standalone simulation and claim 4 with its standalone simulator are not anticipated by the prior art of record.

Neither Beall nor any other reference of record, whether taken alone or in any combination, shows or suggests the features of claims 1 and 4. These claims are, therefore, patentable over the art and since all of the dependent claims are ultimately dependent thereon, they are patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-5 are solicited.

If an extension of time is necessary, petition for extension is herewith made. Kindly charge the fee due for such an extension, or any other fees which might be due with this response to deposit account No. 12-1099.

Respectfully submitted,

For Applicants

WHS:bh

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